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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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Steven W. Lundberg

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EXAMINER

OUELLETTE, JONATHAN P

ART UNIT

PAPER NUMBER

3629

DATE MAILED: 04/13/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/087,561	Applicant(s) LUNDBERG ET AL.	
	Examiner Jonathan Ouellette	Art Unit 3629	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-36 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-36 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>20020301, 20021001</u> . | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. **Claim 5 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.**
3. Claim 5 recites the limitation "the IDS table" in the system as recited in claim 1. There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. **Claims 1-29 and 31-36 are rejected under 35 U.S.C. 102(e) as being anticipated by Grainger et al. (US 2002/0065677 A1).**

6. As per **independent Claim 1**, Grainger discloses a system for managing information disclosure statement (IDS) references, comprising: a computing system (Fig.1); a first software component operable on the computing system to generate a plurality of IDS forms (Fig.5, Para 0038-0039, computer and transmit IDS using IDS generation program); and a second software component operable on the computing system to manage IDS references for at least one organization; wherein each organization only has access to its own IDS references (Para 0038, Documents stored in user database; Para 0079-0081, restricted access).
7. As per Claim 2, Grainger discloses a third software component operable on the computing system to provide a presentation for managing the IDS references associated with each matter of the at least one organization (Figs.13A-20).
8. As per Claim 3, Grainger discloses a fourth software component operable on the computing system to manage matters for the at least one organization; wherein the second software component is a part of the fourth software component (Fig.13A, Prior Art associated with Case).
9. As per Claim 4, Grainger discloses a fifth software component operable on the computing system to manage activities within matters; a sixth software component operable on the computing system to manage organizations; a seventh software component operable on the computing system to manage tasks within matters; an eighth software component operable on the computing system to provide communications; and a ninth software component operable on the computing system to provide security; wherein the third, fourth, fifth, sixth, seventh, eighth, and ninth software components are capable of

interfacing with the first and second software components in a patent prosecution enterprise application (Figs.13A-20).

10. As per Claim 5, as understood by the Examiner, Grainger discloses wherein the IDS references comprise: an IDS holder; an IDS patents holder related to the IDS holder; an IDS publications holder related to the IDS table; and an IDS source holder to indicate how to access the stream of data associated with each IDS reference (Figs.13A-20).
11. As per Claim 6, Grainger discloses a matter holder related to the IDS holder; and an organization holder related to both the IDS holder and the IDS source holder(Figs.13A-20).
12. As per Claim 7, Grainger discloses a database management system to manage the holders (Figs.13A-20).
13. As per Claim 8, Grainger discloses wherein the holders are tables and the data management system is a relational database management system (Figs.13A-20).
14. As per Claim 9, Grainger discloses wherein the holders are classes and the data management system is an object-oriented database management system (Figs.13A-20).
15. As per **independent Claim 10**, Grainger discloses a method for reporting, comprising: receiving a report specification (Electronic File); interpreting the report specification; generating an answer file (converting information format); receiving a plurality of transformations to act on the answer file and a form definition file; and providing a report (Para 0038-0039, Display in IDS form).
16. As per Claim 11, Grainger discloses wherein the report is an information disclosure statement (IDS) form (Para 0038).

17. As per Claim 12, Grainger discloses receiving a question file; wherein interpreting the report specification includes reading the question file (Para 0038).
18. As per **independent Claim 13**, Grainger discloses a method for managing information disclosure statement (IDS) references, comprising: receiving a request to add an new information disclosure statement (IDS) reference to a first matter (Fig.5); searching for all matters related to the first matter (Fig.5, Search for information); and adding the new IDS reference to selected matters related to the first matter (Fig.5, Create form).
19. As per Claim 14, Grainger discloses selecting only those matters related to the first matter with a matter type that supports IDS reference management and only those matters having an appropriate stage (Figs.13A-20).
20. As per Claim 15, Grainger discloses presenting a list of IDS references for a second matter, wherein the second matter is related to the first matter; and indicating the new IDS reference in the list originated in the first matter (Para 0008).
21. As per Claim 16, Grainger discloses indicating the new IDS reference is unmarked and unreviewed (Fig.20)
22. As per **independent Claim 17**, Grainger discloses A system for managing information disclosure statement (IDS) references, comprising: a computing system; a presentation layer operable on the computing system to present an information disclosure statement (IDS) reference inventory system; a business logic layer operable on the computing system to manage the IDS reference inventory system and to generate IDS forms (IDS processing system); and a data layer operable on the computing system to manage the data associated with the IDS reference inventory system (Fig.11).

23. As per Claim 18, Grainger discloses wherein the computing system comprises: a web server; at least one browser in communication with the web server; and a file system accessible to the web server; wherein the presentation layer, the business logic layer, and the data layer operate on the web server (Fig.11).
24. As per Claim 19, Grainger discloses wherein the computing system comprises: a web server; at least one browser in communication with the web server; and a database management system accessible to the web server; wherein the presentation layer and the business logic layer operate on the web server and the data layer operates on the database management system (Fig.11).
25. As per Claim 20, Grainger discloses wherein the computing system comprises: a web server; at least one browser in communication with the web server; an application server in communication with the web server; and a database management system in communication with the application server; wherein the presentation layer operates on the web server, the business logic layer operates on the application server, and the data layer operates on the database management system (Fig.11).
26. As per **independent Claim 21**, Grainger discloses a computer-readable medium storing computer-executable instructions for performing a method, the method comprising: providing a presentation capable of associating at least one information disclosure statements (IDS) reference to at least one matter; and providing a presentation capable of listing each IDS reference associated with each matter (Figs.13A-20).
27. As per Claim 22, Grainger discloses providing a presentation capable of generating an IDS form for at least one matter (Para 0038-0039).

28. As per Claim 23, Grainger discloses providing a presentation capable of modifying at least one IDS reference associated with at least one matter (Figs.13A-20).
29. As per Claim 24, Grainger discloses providing a presentation capable of deleting at least one IDS reference associated with at least one matter (Figs.13A-20).
30. As per Claim 25, Grainger discloses providing a presentation capable of searching all IDS references associated with one matter (Figs.13A-20).
31. As per Claim 26, Grainger discloses providing a presentation capable of searching all IDS references owned by one organization (Figs.13A-20).
32. As per Claim 27, Grainger discloses providing a presentation capable of marking at least one IDS reference associated with at least one matter (Figs.13A-20).
33. As per Claim 28, Grainger discloses providing a presentation capable of updating a review status of at least one IDS reference associated with at least one matter; and providing a presentation capable of showing the review status of each IDS reference associated with at least one matter (Fig.20)
34. As per Claim 29, Grainger discloses restricting access to IDS references so that each organization only has access to its own IDS references, unless an individual from a first organization is invited into a matter of a second organization (Para 0079-0081, Restricted Access code provided to additional users).
35. As per Claim 31, Grainger discloses wherein presentation capabilities for each individual are determined based on their role in a matter and an organization associated with each individual (Para 0079-0081, Restricted Access).

36. As per Claim 32, Grainger discloses providing a presentation capable of uploading a stream of data associated with the at least one IDS reference (Para 0054, Activate Link/Pointer to IDS file).
37. As per Claim 33, Grainger discloses providing a presentation capable of downloading the stream of data associated with the IDS reference (Para 0054, Attach Link/Pointer to IDS file).
38. As per Claim 34, Grainger discloses providing links for various applications capable of opening and displaying the stream of data (Para 0054, Attach Link/Pointer to IDS file).
39. As per Claim 35, Grainger discloses providing a presentation capable of uploading a plurality of streams of data associated with IDS references, the IDS references being associated with a plurality of matters (Para 0054, Attach Link/Pointer to IDS file).
40. As per **independent Claim 36**, Grainger discloses a system, comprising: a host organization managing a plurality of matters (Cases); and a plurality of attorneys some of which belong to different law firms associated with the plurality of matters (Client systems); wherein a first set of attorneys of the plurality of attorneys are associated with a first law firm and have access to selected matters in the plurality of matters, but have no access to other matters in the plurality of matters (Para 0062, 0090, Restricted Access); wherein attorneys other than those in the first set of attorneys are associated with at least one law firm other than the first law firm and have access to matters other than the selected matters (Para 0079-0081, 0090, additional client with separate access rights); wherein a reference associated with one of the selected matters is propagated to a new matter that is not in the selected matters (Para 0008); wherein the attorneys other than

those in the first set of attorneys do not have access to the new matter (Para 0079-0081, 0090, Restricted Access).

Claim Rejections - 35 USC § 103

41. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

- (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

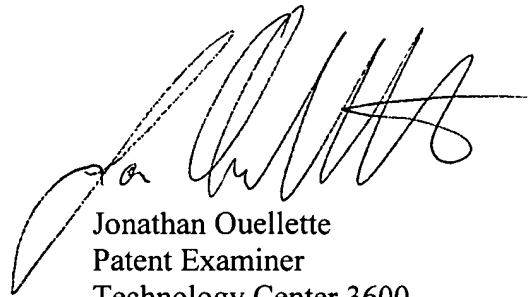
42. **Claim 30 is rejected under 35 U.S.C. 103(a) as being unpatentable over Grainger in view of Official Notice.**

43. As per Claim 30, Grainger fails to expressly disclose providing an accounting system to track costs associated with storing IDS references.
44. However one advantage to Grainger's system is the ability to manage costs involved with handling IDS information (Para 0089). Furthermore, Official Notice is taken that the accounting function was a well-known part of doing business when the invention was made, for the purpose of tracking expenses and revenues of a company for owner/stockholder and government/tax reasons. Finally, the database costs would be an obvious accounting element to track in such a database intensive system.

Conclusion

45. Additional Literature has been referenced on the attached PTO-892 form, and the Examiner suggests the applicant review these documents before submitting any amendments.
46. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jonathan Ouellette whose telephone number is (571) 272-6807. The examiner can normally be reached on Monday through Thursday, 8am - 5:00pm.
47. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on (571) 272-6812. The fax phone numbers for the organization where this application or proceeding is assigned (571) 273-8300 for all official communications.
48. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Office of Initial Patent Examination whose telephone number is (703) 308-1202.

April 7, 2006



Jonathan Ouellette
Patent Examiner
Technology Center 3600